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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,482	07/10/2000	Albert K. Chin	4589	1945

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EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/614,482

Applicant(s)
Chin

Examiner
Michael Thaler

Art Unit
3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 30, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3731

Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 4.

Claims 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The surgical instrument is not part of the claimed combination as indicated by the phrase "for housing a surgical instrument" in claim 1, line 6. However, claim 11 is inconsistent with claim 1 since it implies that the surgical instrument (the surgical bisector) is part of the claimed combination. Claim 14 has a similar problem.

Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scwemberger et al. (5,569,292). Scwemberger et al. show first lumen (within hollow shaft 12) for housing an endoscope therein (col. 6, lines 44-47), transparent tip 14 and second lumen (within cannula 17) for housing a surgical instrument (one of the additional instrumentation described in col. 6, lines 54-59) for performing procedures on tissue viewed (which was viewed) through the transparent tip 14 when the endoscope was present in the cannula 17. The Scwemberger et al. drawings fail to specifically show the open distal end of second lumen positioned intermediate the proximal and distal ends of the first lumen.

Art Unit: 3731

However, the open distal end of second lumen is obviously positioned intermediate the proximal and distal ends of the first lumen since the transparent tip 14 extends significantly distally beyond the distal end of the first lumen as seen in figures 1 and 3. As to claims 2, 3, 5, 11, 14 and 15, the surgical instrument is not part of the claimed combination as indicated in claim 1, line 6. As to claim 13, Scwemberger et al. show a transition contour where the distal end of shaft sleeve 20 merges with the exterior surface of shaft 12.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scwemberger et al. (5,569,292) in view of Wilk et al. (5,938,586). Scwemberger et al. fail to show a flexible hood coupled to the distal end of the second lumen. However, including a flexible hood on the distal end of the Scwemberger et al. second lumen (within cannula 17) in order to seal the end of the cannula and yet permit an instrument to pass therethrough would have been obvious since it is well known in this art to provide such a flexible hood for this reason. For example, Wilk shows flexible hood (602 or 608) on the distal end of an instrument lumen 604. Including a flexible hood on the distal end of the second lumen (within cannula 17) of Scwemberger et al. for this reason would have been obvious.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3731

Applicant's arguments filed Jan. 30, 2003 have been fully considered but they are not persuasive. The allegation that Scwemberger et al. show only one lumen is not well founded since the reference shows one lumen within hollow shaft 12 and one lumen within cannula 17 as broadly claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be

Art Unit: 3731

reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
February 25, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731